

~~REMARKS~~

Applicants appreciate the withdrawal of the previous rejections and the issuance of the present Action as a non-final Action.

Applicants have added claims 36-40 and canceled claims 5 and 21-27. Accordingly claims 1-4, 6-20, 28-40 are pending in the present application.

Claims 21-27 stand rejected under 35 USC 101 as being directed to non-statutory subject matter. Claims 1-20 and 28-35 stand rejected under 35 USC 103(a) for obviousness over Internet Appliances (IA) (references labeled "X" and "UU" by the Office) in view of U.S. Patent No. 6,405,178 to Manchala et al. Claims 21-27 stand rejected under 35 USC 103(a) for obviousness over IA in view of Manchala and further in view of Official Notice (ON).

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to the obviousness rejections, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 2).

The Office provides a motivational rationale on page 7 in support of the 103 rejection as "in order to be more proactive in printer servicing." Applicants respectfully submit the motivation is not properly supported by the objective evidence of record. Applicants respectfully refer the Office to the authority of *In re Lee* provided in the previous responses regarding proper motivation to combine or modify prior art references. In particular, the Court stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence. In the instant case, the record is void of any evidence to support the motivation of becoming "more proactive" apart from the bald conclusory statements of the Office which are insufficient for proper motivation as set forth by the Federal Circuit. For

S/N: 09/976,642
PDNO. 10007583-1
Amendment C

BEST AVAILABLE COPY

example, as recognized by the Office on page 6 of the Action, IA already teaches internet appliances becoming more proactive using embedded web server technology. Further, the Action on page 6 states that the incorporation of email into a Xerox color laser printer to send email to an administrator when the printer requires or soon will require service provides a proactive system. Accordingly, *references IA already disclose a "proactive" arrangement and there is absolutely no evidence of record that modification of the teachings of IA per Manchala would result in any "more proactive in printer servicing" compared with the unmodified references IA.* Why would one aware of the teachings of IA look to Manchala for teachings directed to the subject matter already disclosed in IA? The answer in view of the lack of any supporting objective evidence of an improvement provided by the combination is the motivation can only result from improper reliance upon Applicants' disclosure. The motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination. *See, e.g., Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicant's respectfully submit the Office has failed to meet their burden of establishing proper motivation for the 103 combination and the 103 rejection is improper for at least this reason.

Applicants also respectfully submit that even if the references are combined, the combination fails to disclose or suggest positively recited limitations of claim 1 and the Office has failed to establish a proper prima facie 103 rejection for this additional reason.

More specifically, referring to the rejection of claim 1, the method includes limitations of claim 5 reciting second determining when a predetermined work threshold has been reached and second transmitting an email to request periodic service in response to the second determining. On page 6 of the Action, the Office states IA teaches sending urgent email to request periodic maintenance referring to the teachings of page 2 of reference UU. Applicants respectfully submit reference UU fails to disclose or suggest the limitations of claim 1.

More specifically, page 2 of reference UU merely states that *more complex internet appliances* require periodic and often instant maintenance. The teachings of UU regarding "complex" internet appliances needing periodic maintenance are void of any teachings of a hard copy output engine as defined in claim 1. Perhaps even more

S/N: 09/976,642
PDNO. 10007583-1
Amendment C

compelling, the bald cursory statement that complex internet appliances require periodic maintenance provides no teachings as to how the periodic maintenance is provided or performed. In no fair interpretation can such bald, cursory teachings of reference UU be considered to disclose or suggest the positively recited limitations of determining by a *processor within a hard copy output engine when a predetermined work threshold has been reached or transmitting an email to request periodic service in response to the determining*. In addition, Applicants have failed to uncover any teachings in Manchala with respect to periodic maintenance or transmission of an email to request periodic service in response to the claimed determining when a predetermined work threshold has been reached. Accordingly, even if the reference teachings are combined, the combination fails to disclose or suggest positively-recited limitations of claim 1 and claim 1 is allowable for at least this reason.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 8, Applicants respectfully submit there is no motivation to combine the teachings of Manchala with the teachings of references IA and Applicants respectfully submit the Office has failed to establish a proper 103 rejection for at least this reason.

In addition, positively recited limitations of the claims are not disclosed by the prior art even if the references are combined. More specifically, the mere observation that more complex appliances may require periodic service fails to provide any teachings with respect to how periodic servicing is carried out let alone the specific limitations of claim 8. The teachings of the prior art even if combined fail to disclose or suggest the positively-recited limitations of claim 8 reciting transmitting an email to request periodic service. Further, the teachings of the prior art taken alone or in combination fail to disclose or suggest requesting of periodic service in response to a predetermined work threshold being reached. Positively-recited limitations of claim 8 are not disclosed nor suggested by the prior art and claim 8 is allowable for at least this reason.

The claims which depend from independent claim 8 are in condition for allowance for the reasons discussed above with respect to the independent claim as

S/N: 09/976,642
PDNO. 10007583-1
Amendment C

well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 15, there is no motivation to combine the teachings of Manchala with the teachings of references IA and Applicants respectfully submit the Office has failed to establish a proper 103 rejection for at least this reason.

In addition, the system of claim 15 recites limitations of claim 18 defining processing circuitry configured to transmit an email to a personal computer associated with the peripheral device for retransmission from the personal computer to a vendor web site across a firewall. Applicants have failed to uncover any teachings in the prior art regarding retransmissions of an email let alone the specific limitations of claim 15 with respect to retransmission including retransmission to a vendor web site across a firewall as explicitly claimed. Accordingly, even if the reference teachings are combined, the combination fails to disclose or suggest positively-recited limitations of claim 15 and claim 15 is allowable for at least this reason.

Applicants have failed to uncover in the Office Action any identification of reference teachings which allegedly disclose or suggest the above-identified limitations of claim 15 as were recited in original claim 18. In the event that a rejection of claim 15 is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable*. Applicants respectfully request clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if claim 15 is not found to be allowable.

The claims which depend from independent claim 18 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicants hereby add new claims 36-40 which are supported at least by Fig. 3

S/N: 09/976,642
PDNO. 10007583-1
Amendment C

13

~~and the associated teachings~~ of the specification.

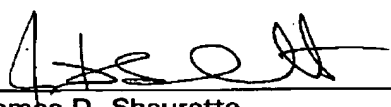
Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Robert E. Haines
Mark A. Harper

By:


James D. Shaurette

Reg. No. 39,833

Date: 11/14/05

S/N: 09/976,642
PDNO. 10007583-1
Amendment C